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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,027	01/28/2002	Toru Karasawa	111796	1264

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Oliff & Berridge  
PO Box 19928  
Alexandria, VA 22320

EXAMINER

ZHOU, TING

ART UNIT PAPER NUMBER

2173

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/048,027	<b>Applicant(s)</b> KARASAWA ET AL.	
	<b>Examiner</b> Ting Zhou	<b>Art Unit</b> 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 and 22-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/11/02</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicants' response filed on 9 November 2004 have been received and entered. In the response to restriction requirement mailed on 21 October 2004, applicants have provisionally elected Group I, claims 1-10 and 20-21, with traverse.
2. Applicants' election with traverse of Group I, claims 1-10 and 20-21, in the reply filed on 9 November 2004 is acknowledged. The traversal is on the ground(s) that the subject matter of all claims 1-37 is sufficiently related that a thorough search for the subject matter of any one group of claims would encompass a search for the subject matter of the remaining claims. This is not found persuasive because the applicants' arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims are sufficiently related that a thorough search for the subject matter of any one group of claims would encompass a search for the subject matter of the remaining claims without specifically pointing out how the language of the claims supports applicants' traversal of the restriction requirement. Absent the mere allegation that the search and examination of the entire application could be made without serious burden, the applicant has failed to provide substantive reasoning as to why the restricted groups of claims are not patentably distinct from one another.
3. The applicants assert that the subject matter of claims 1-37 are sufficiently related that a thorough search for the subject matter of any one group of claims would encompass a search for the subject matter of the remaining claims, and thus, the search and examination of the entire application could be made without serious burden. The examiner respectfully disagrees. Group

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I, claims 1-10 and 20-21, is classified in class 715, subclass 730, Group II, claims 11-19, is classified in class 353, subclass 30 and Group III, claims 22-37, is classified in class 715, subclass 733. Due to the different classification of the aforementioned three groups, a different search would need to be conducted by the examiner in order to fully examine the subject matter of the respective groups. Furthermore, the three groups are distinct from each other because the invention of each group is separately usable. The invention of Group I has the utility of a scenario creating device for readily creating a scenario file only by operating a pointing device. The invention of Group II has the utility of an optical projection system for preparing and displaying images. The invention of Group III has the utility of conducting data storage and transfer of images between connected devices in a network.

4. The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 4, 10, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Tatsuji JP 8 - 153104.

Referring to claims 4, 20 and 21, Tatsuji teaches a scenario creating device, method and computer-readable storage medium comprising an input section including a pointing device (input part 11 comprising input devices such as a keyboard and mouse) (paragraphs 0021-0022 and Figure 1); a display section (output monitor) (paragraphs 0021-0022 and Figure 1); and a scenario creating section for creating the scenario file in accordance with operation of the input section (the editor creates the scenario, or link order of the cards of a presentation for display) (paragraphs 0025-0032); wherein the scenario creating section provides a display of a scenario file creation area on the display section (scenario window 201 in Figure 8), the scenario file creation area including a file management area for displaying source files and a selected source file information area for displaying, in a sequence selected by a user, selected source file information representing information of a source file selected by the user in the file management area (displaying the source files, or cards of the presentation on the display, and the cards sequentially selected by the user in the scenario window 201) (paragraphs 0053-0058 and Figure 8); and the scenario creating section creates the scenario file in response to a content of the display in the selected source file information area (user's input of a scenario creation completion commands creates scenario information according to the order of the card arrangement on the scenario window) (paragraph 0058 and Figure 8).

Referring to claim 10, Tatsuji teaches a scenario supplying section for supplying the scenario file created by the scenario creating section to a scenario reproducing device but not supplying a source file, selected during creation of the scenario file, to the scenario reproducing device (outputting the hypermedia document created during document reproduction from the

created scenario information for presentation on the display device) (paragraphs 0017, 0021 and 0026-0028).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsuji JP 8-153104 and Meyn et al. U.S. Patent 5,859,623.

Referring to claims 1, 2 and 3, Tatsuji teaches a scenario creating device, method and computer-readable storage medium comprising an input section including a pointing device (input part 11 comprising input devices such as a keyboard and mouse) (Tatsuji: paragraphs 0021-0022 and Figure 1), a display section (output monitor) (Tatsuji: paragraphs 0021-0022 and Figure 1), and a scenario creating section for creating the scenario file in accordance with operation of the input section (the editor creates the scenario, or link order of the cards of a presentation for display) (Tatsuji: paragraphs 0025-0032); and wherein the scenario creating section provides a display of an execution icon on the display section for causing the scenario creating section to execute a process (displaying edit icon 102 in Figure 6) for carrying out a list display function) (Tatsuji: paragraphs 0049-0051), and in response to operation of the pointing device, the scenario creating section creates the scenario file of the predetermined format on the

basis of the image information (in response to an input document, creating the hypermedia document via assigning information to the cards according to the logic structure file and displaying the cards together with the link order defined between them) (Tatsuji: paragraphs 0013, 0015-0017 and 0025-0032). Although Tatsuji teaches a file icon for a source file of a predetermined format including pagewise scenario information and image information (as shown in Figure 8, a plurality of cards, or icons for the files of the input document are displayed) (Tatsuji: paragraphs 0051-0053), Tatsuji fails to explicitly teach dragging and dropping a file icon on the execution icon by means of operation of the pointing device. Meyn et al. teach an interface for displaying and manipulating a scenario file (presentation) (Meyn et al.: column 10, lines 49-67) similar to that of Tatsuji. In addition, Meyn et al. further teach dragging and dropping a file over an icon in order to execute a function (Meyn et al.: column 12, lines 57-20). It would have been obvious to one of ordinary skill in the art, having the teachings of Tatsuji and Meyn et al. before him at the time the invention was made, to modify the interface for creating a scenario file taught by Tatsuji to include the drag-and-drop functionality of Meyn et al. One would have been motivated to make such a combination in order to provide an improved system for organizing, displaying, managing and selecting icons on a computer graphical interface, thereby simplifying a user's interactions with a computer.

7. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsuji JP 8-153104, as applied to claim 4 above, and Meyn et al. U.S. Patent 5,859,623.

Referring to claim 5, Tatsuji teaches all of the limitations as applied to claim 4 above. Although Tatsuji teaches the scenario creating section being capable of creating the scenario file

(Tatsuji: Figure 8), Tatsuji fails to explicitly teach the indication of a plurality of source files. Meyn et al. teach an interface for displaying and manipulating a scenario file (presentation) (Meyn et al.: column 10, lines 49-67) similar to that of Tatsuji. In addition, Meyn et al. further teach indication of a plurality of source files (the Presentation Selector allowing users to select from a plurality of presentation files for display and editing) (Meyn et al.: column 15, lines 1-6 and Figure 4). It would have been obvious to one of ordinary skill in the art, having the teachings of Tatsuji and Meyn et al. before him at the time the invention was made, to modify the interface for creating a scenario file taught by Tatsuji to include the plurality of presentation files of Meyn et al. One would have been motivated to make such a combination in order to provide more functionality to the user, allowing them to have the option to select from among a plurality of presentations.

Referring to claim 6, Tatsuji, as modified, teach the selected source file information is displayed in the selected source file information area when a file icon for a source file displayed in the file management area is dragged and dropped (Meyn et al.: column 12, lines 57-60) into the selected source file information area by means of operation of the pointing device (the selected source card information is displayed in the source file scenario window 201, when the selected file icon, or card displayed on the screen is selected by a mouse operation of a user) (Tatsuji: paragraphs 0055-0057 and Figure 8).

Referring to claim 7, Tatsuji, as modified, teach the selected source file information includes page indicating information indicating a page in the selected source file (indication of the chosen card order) (Tatsuji: paragraphs 0055-0057 and Figure 8).

Referring to claim 8, Tatsuji, as modified, teach a reduced image display area for displaying pagewise image information as a reduced pagewise image with regard to a source file of a predetermined format including pagewise scenario information and image information (Figure 8 of Tatsuji shows the display of the source file, i.e. the 12 cards making up the presentation and the display of reduced pagewise images, i.e. the display of each individual card representing part of the presentation), the source file being displayed in the file management area; and when a reduced pagewise image displayed in the reduced image display area is dragged and dropped (Meyn et al.: column 12, lines 57-60) into the selected source file information area by means of operation of the pointing device, the selected source file information including the page indicating information is displayed in the selected source file information area (upon user selection of a reduced pagewise image, i.e. a card of the presentation, with a mouse, the selected image, or card, is displayed in the selected source file information area, or scenarios window 201) (Tatsuji: paragraphs 0054-0058 and Figure 8).

Referring to claim 9, Tatsuji, as modified, teach a network interface wherein the scenario creating section selects a source file stored in another external device connected to the network (the bus interface connects several external devices, such as a floppy disk drive 45 to the personal computer, allowing users to select a source file, i.e. PDF file, stored in the external floppy disk drive) (Meyn et al.: column 4, line 42 – column 5, line 65) and creates the scenario file (Tatsuji: paragraph 0013).

8. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider

these references fully when responding to this action. The documents cited therein teach similar methods of creating scenario files for slide presentations.

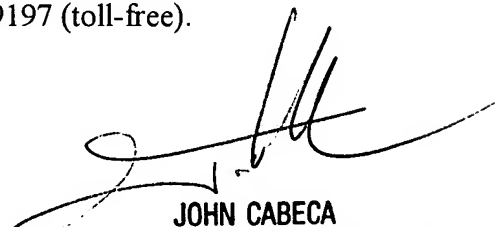
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-4058.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21 January 2005

  
JOHN CABECA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER